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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/621,400	07/21/2000	William Dere	11283/11	3539

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EXAMINER

CHEN, TE Y

ART UNIT	PAPER NUMBER
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2171

DATE MAILED: 07/31/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/621,400

Applicant(s)

Alameda et al.

Examiner

Te Chen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jul 21, 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2 6) ☐ Other:

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DETAILED ACTION

1. Claims 1-38 are presented for examination.
2. It is noted that although the present application does not contain line numbers in the claims, which do not correspond to the preferred format. The preferred format is to number each line of every claim, with each claim beginning with line 1. For ease of reference by both Examiner and Applicant all future correspondence should include the recommended line numbering.

Specification

3. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicants' cooperation are requested in correcting any errors of which applicants may become aware in the specification.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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5. Claim 21 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the Setup program to receive at least one of the license files from the automated license Daemon program, does not reasonably provide enablement for the Setup program to receive error messages from the automated license Daemon program. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

As to claim 21, applicant claimed that “the Setup program receives at least one of the license files and error messages from the automated license Daemon program”. However, base on Fig. 6 of the instant specification, an application with license management (LM) error, will prevent the setup program to receive any license file.

6. Claim 22 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

As to claim 22, applicant cited that “an installation of at least one license on the “user/client” server is performed by the Setup program”. However, base on Fig. 6, if a LM error being detected during the installation process, then no license will be installed on the client

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machine by the Setup program. Since the statement of this claim controverts the disclosure of applicant's specification, hence it is not in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claims 1, 17, 26 and 33, it is not understood what is it meant by "user/client" [i.e., is "/" referred to the word "or" or "and" or others?].

As to claim 5, this claim has an ambiguous dependency because applicant cited that "The method according to claim 5...", wherein claim 5 is the instant claim.

As to the other dependent claims, since they have the same defect as their base claims, hence were rejected for the same reason.

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Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Coley (U.S. Patent No. 5,790,664) and in view of Nabahi (U.S. Patent No. 6,006,035).

As to claim 17, Coley (hereinafter referred as Coley) disclosed a system for managing an automated license installation on a client machine [Fig. 1], which comprising:

- a) a client module in a client machine [108, Fig. 1];
- b) an automatic license Daemon program with which the client module communicates [114, Fig. 1; col. 7, lines 53-54];
- c) a license database to store license information for the installation [112, Fig. 1; col. 8, lines 9-11].

Although Coley did not specifically teach that a client module having a Setup program.

However, Nabahi taught a standard client module program having a Setup program which will enable the software installation [col. 1, line 58 - col. 2, line 34]. Thus, it would have been

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obvious to one of the ordinary skill in the art to combine the teachings of Coley and Nabahi, because by adding the Setup program in Coley's client module, would allow the system bind to the standard of an installation and facilitate the processing.

As to claim 18, Nabahi and Coley teach the invention substantially as claimed. Coley further teach that the automated license daemon program, will retrieve at least one license [108, 114, Fig. 1; col. 8, lines 5-12].

As to claim 19, Nabahi and Coley teach the invention substantially as claimed. Coley further teach that the automated license daemon program resides on a server [110 and 114, Fig. 1].

As to claim 20, Nabahi and Coley teach the invention substantially as claimed. Nabahi further teach that the Setup program sends client information to the automated license daemon program [col. 2, lines 25-34; Fig. 1].

As to claim 23, Nabahi and Coley teach the invention substantially as claimed. Coley further teach that the communication of the automated license Daemon program and the client module is via a bidirectional HTTP socket connection [106, 116, Fig. 1].

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As to claims 24 and 25, Coley further teach that the database contains a master copy of customer licenses [col. 4, lines 25-31] and the information on the database can be updated independently [col. 10, lines 36-41].

As to claims 33-37, these claims recited similar subject matters as claims 17-25, hence were rejected under the same rationale.

As to claims 1-12, 26-39 and 38, applicant recites similar features of claims 17-25 and 33-37, in form of computer medium product or methods, since the functions of these claims are disclosed and or suggested by Coley and Nabahi as a combination discussed above, thus these claims were rejected for the same reasons.

Conclusion

11. The prior art made of record and is considered pertinent to applicant's disclosure, therefore, it is suggested to read: Larose et al. (U.S. Patent No. 6,108,420), which disclosed a method and system for networked installation of uniquely customized, authenticable, and traceable software applications; Smith et al. (U.S. Patent No. 6,067,582), which disclosed a system for installing software package on a distributing network environment.

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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Chen whose telephone number is (703) 308-1155. The examiner can normally be reached Monday through Friday from 7:30 A.M. to 4:30 P.M.

13. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached at (703) 308-1436. The fax phone numbers for this group are as following:

(703) 746-7238 (After Final Communication);

(703) 746-7239 (Official Communications); and

(703) 746-7240 (For Status Inquiries, Draft Communication).

14. Any inquiry of a general nature of relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-9600.

Susan Chen

Jun. 12, 2002



SAFET METJAHIC
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100